

### REMARKS

Claims 1, 4, 5, 7-11, 14, 15 and 20-29 are pending. By this Amendment, claim 6 is cancelled without prejudice or disclaimer; claims 1, 7-11, 15 and 28 are amended; and claim 29 is added. Reconsideration and allowance in view of the above amendments and following remarks are respectfully requested.

Claims 1, 4, 5, 14, 15 and 28 were rejected under 35 U.S.C. §102(e) Konya et al. (U.S. Patent 6,777,152); and claims 1, 4-11, 14, 15 and 20-28 were rejected under 35 U.S.C. §103(a) over Konya et al. in view of the Handbook of Imaging Materials, 2nd Edition, by Diamond et al. (hereinafter "Diamond et al."). The rejections are respectfully traversed.

The subject matter of cancelled claim 6 has been incorporated into claims 1 and 28.

Applicants respectfully disagree with the conclusion of the Office Action that the "product by process limitations" of claims 1 and 28 appear to be met by Konya et al. because Konya et al. disclose binder resin and colorants.

MPEP § 2113 states: The structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.

Konya et al. disclose an electrostatic image developer comprising spherical complex oxide fine particles of amorphous silica-titania obtained by atomizing a siloxane and an organic titanium compound in a flame for combustion. See claim 1 (column 13, lines 53-58). As further disclosed by Konya et al., the combustion forms core particles of silica and titania which coalesce and grow into particles whose ultimate size and shaped are determined by the

flame temperature, silica and titania concentrations, and residence time within the flame, with the flame temperature being predominant. See column 5, lines 10-14.

It is respectfully submitted that one of ordinary skill in the art would recognize that a wet granulating method, as recited in claims 1 and 28, would impart distinctive structural characteristics to a toner that are different than a toner formed by atomizing a siloxane and organic titanium compound in a flame for combustion, as disclosed by Konya et al. Furthermore, the Examiner has acknowledged that claim 6, which has been incorporated into claims 1 and 28, is not anticipated by Konya et al. Accordingly, it is respectfully submitted that Konya et al. do not anticipate claims 1 and 28.

With respect to claims 10 and 24, it is respectfully submitted that the claimed hydrophobicity is not inherent in the disclosure of Konya et al.

MPEP §2112 states: The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. (Underlining emphasis in original.) MPEP §2112 further states: In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (Underlining emphasis in original.)

It is respectfully submitted that the Office Action does not present any basis in fact and/or technical reasoning to reasonably support the determination that the claimed hydrophobicity is an inherent characteristic of Konya et al. Column 9, lines 33-46, of Konya et al. merely disclose the process for obtaining a hydrophobized spherical complex oxide fine powder. There is no disclosure of the claimed hydrophobicity. In other words, although the claimed hydrophobicity may result from the process disclosed by Konya et al., in the absence

of the required basis in fact and/or technical reasoning, there is no evidence that the claimed hydrophobicity necessarily results from the process of Konya et al.

The Office Action acknowledges that the subject matter of cancelled claim 6 is not disclosed or suggested by Konya et al. It is respectfully submitted that Diamond et al. fail to cure the deficiencies of Konya et al. with respect to this feature (i.e. average degree of roundness of not less than 0.950) as the combination fails to include all the claimed features and because there is no teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references. See MPEP §2143.

As disclosed, for example, in paragraph [0004] of the instant application, a toner obtained through a wet granulating method has a greater moisture absorbing property compared to a toner obtained through a pulverizing method, and is therefore subjected to serious degradation in its charging ability. In a pulverizing method, ultra-fine particles that can not be removed by a usual classification adhere to the surfaces of toner particles and may disturb the performance of external additives. However, in a wet granulating method, ultra-fine particles are hardly generated, and the charging stability is not disturbed by ultra-fine particles, but is disturbed by the greater moisture absorbing property. As further disclosed, for example, in paragraph [0018], providing an external additive comprising composite oxide fine particles having a specific surface area of not more than  $300 \text{ m}^2/\text{g}$  improves the charging stability against continuous use and environmental fluctuations and fogging and filming.

Diamond et al. do not disclose or suggest an external additive comprising composite oxide fine particles having a specific surface area of not more than  $300 \text{ m}^2/\text{g}$ . Therefore, even assuming it would have been obvious to combine Konya et al. and Diamond, which

Applicants do not concede, the combination would not include all the features of claims 1 and 28 and would not present a *prima facie* case of obviousness.

It is also respectfully submitted that Diamond et al.'s disclosure that aggregation techniques allow a range of morphologies from "potato" to sphere is not a disclosure or suggestion of an average degree of roundness of not less than 0.950. Moreover, there is no disclosure or suggestion by Diamond et al. of the claimed surface area of the external additive and the claimed average degree of roundness of the toner particles. The combination of Konya et al. and Diamond et al. thus would not have resulted in the inventions of claims 1 and 28.

As discussed above, Konya et al. disclose an electrostatic image developer comprising spherical complex oxide fine particles of amorphous silica-titania obtained by atomizing a siloxane and an organic titanium compound in a flame for combustion, wherein the flame causes coalescence and growth of particles whose ultimate size and shape is determined, predominantly, by the flame temperature. Diamond et al. disclose that the problem of polymerization caused by pigment incorporation can be avoided by starting the toner preparation process with a submicron polymer latex and aggregating it with a pigment dispersion. One of ordinary skill in the art would not have been motivated to combine these different disclosures and teachings.

Claims 4, 5, 7-11, 14, 15, 20-27 and 29 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claims 1 and 28 and for the additional features recited therein.

Reconsideration and withdrawal of the rejections over Konya et al. and Konya et al. in view of Diamond et al. are respectfully requested.

In view of the above amendments and remarks, it is respectfully submitted that all of the claims are allowable and the entire application is in condition for allowance.

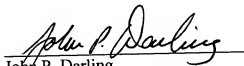
Should the Examiner believe that anything further is necessary to place the application in condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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